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IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

29 Nikola Corporation, a Delaware
30 corporation,

31 Plaintiff/Counter Defendant,

32 vs.

33 Tesla, Inc., a Delaware corporation,

34 Defendant/Counterclaimant.

Case No.: 3:18-CV-07460-JD

Hon. James Donato

**RESPONSE TO TESLA INC.'S
COUNTERCLAIMS**

1 Pursuant to Federal Rule of Civil Procedure 12(a)(1)(B), Nikola Corporation responds
2 to Tesla, Inc's counterclaims.

3
4 **PARTIES**

5 1. Nikola lacks sufficient information to admit or deny the allegations in this
6 paragraph 1, and therefore denies the allegations.

7 2. Admitted.

8
9 **JURISDICTION AND VENUE**

10 3. Nikola admits that the counterclaim purports to seek a declaratory judgment
11 under 28 U.S.C. §§ 2201, 2202.

12 4. Paragraph 4 contains a legal conclusion, which does not require an answer. To
13 the extent an answer is required, Nikola does not contest subject matter jurisdiction.
14

15 5. Nikola denies that venue is proper under 28 U.S.C. § 1391. Nikola further denies
16 that this Court is Nikola's choice of forum. Nevertheless, Nikola will not contest venue.

17 6. Nikola admits that it is enforcing United States Patents Nos. D811,944 (the
18 "'D944 Patent"), D811,968 (the "'D968 Patent"), D816,004 (the "'D044 Patent"), and
19 10,077,084 (the "'084 Patent") (collectively the "Patents-inSuit") and Nikola's Nikola One
20 trade dress against Tesla. Nikola denies any other allegation in paragraph 6 except as
21 specifically admitted.
22

23 7. Nikola admits that it owns the 'D944 Patent, the 'D968 Patent, the 'D004 Patent,
24 and the '084 Patent.
25
26
27
28

1 8. Nikola admits that Tesla purports to deny infringing the Patents-in-Suit. Nikola
2 asserts that Tesla infringes the Patents-in-Suit and denies any other allegation contained in
3 paragraph 8.
4

5 9. Nikola admits that Tesla purports to assert that the Patents-in-Suit are invalid.
6 Nikola denies that the Patents-in-Suit are invalid and denies any other allegation in paragraph
7 9.
8

9 10. Nikola admits that it owns the Nikola One trade dress.

10 11. Nikola admits that Tesla purports to deny that it infringes on any protectable
11 Nikola trade dress. Nikola asserts that the Nikola One trade dress is protectable and Tesla
12 infringes the Nikola One trade dress. To the extent not admitted, Nikola denies any other
13 allegation in paragraph 11.
14

15 12. Nikola admits that Tesla purports to allege that the Nikola One trade dress is
16 invalid for inherent distinctiveness, lacks secondary meaning, and is functional. Nikola asserts
17 that the Nikola One trade dress is protectable. To the extent not admitted, Nikola denies any
18 other allegation in paragraph 12.
19

20 13. Nikola admits that an actual controversy exists between Nikola and Tesla.
21

22 **NIKOLA DENIES ANY INEQUITABLE CONDUCT DURING PROSECUTION OF**
23 **THE ‘D944 PATENT, THE ‘D968 PATENT, AND THE ‘D004 PATENT.**

24 14. Nikola admits that Adriano Mudri is the designer of the Road Runner concept
25 truck. Nikola lacks any information to admit or deny the remaining allegations in paragraph
26 14 and denies those allegations on that basis. Nikola lacks information as to the veracity or
27 authenticity of the photographs in paragraph 14 and further denies any allegation based on the
28 pictures.

1 15. Nikola admits that Trevor Milton is the founder of Nikola and one of the named
2 inventors on the 'D944 Patent, the 'D968 Patent, and the 'D044 Patent. Nikola admits that
3 Milton met with Mudri in 2015. Nikola denies any other allegation in paragraph 15 that is not
4 specifically admitted.
5

6 16. Admitted.

7 17. Admitted

8 18. Admitted.

9 19. Nikola admits that named inventors and their attorneys have a duty of candor to
10 the United States Patent and Trademark Office.
11

12 20. Admitted.

13 21. Admitted.

14 22. Denied.

15 23. Denied.

16 24. Denied.

17 25. Denied.

18 26. Denied.

19 27. Denied.

20 28. Denied.

21 29. Denied.

22 30. Denied.

FIRST COUNTERCLAIM – DECLARATION OF NONINFRINGEMENT
OF THE ‘D944 PATENT.

31. Nikola incorporates Paragraphs 1-13 of its Answer to Tesla’s Counterclaim as if fully set forth.

32. Nikola admits that Tesla purports to allege in paragraph 32 that it does not infringe the ‘D944 patent. Nikola asserts that Tesla infringes the ‘D944 patent and Tesla has failed to allege the necessary elements to state a claim for declaratory judgment of noninfringement.

33. Denied.

SECOND COUNTERCLAIM – DECLARATION OF PATENT INVALIDITY
OF THE ‘D944 PATENT.

34. Nikola incorporates Paragraphs 1-13 of its Answer to Tesla’s Counterclaim as if fully set forth.

35. Nikola admits that Tesla purports to allege in paragraph 35 that the ‘D944 Patent is invalid. Nikola denies that the ‘D944 patent is invalid and asserts that Tesla has failed to allege the necessary elements to state a claim for declaratory judgment of patent invalidity.

36. Nikola denies that any of the references cited are invalidating prior art. Nikola has no knowledge of the veracity or authenticity of the pictures included in paragraph 36 and as such denies the allegations on that basis.

37. Nikola denies that Tesla is entitled to a judicial declaration that the ‘D944 Patent is invalid.

THIRD COUNTERCLAIM – DECLARATION OF NONINFRINGEMENT
OF THE ‘D968 PATENT.

38. Nikola incorporates Paragraphs 1-13 of its Answer to Tesla’s Counterclaim as if fully set forth.

39. Nikola admits that Tesla purports to allege in paragraph 39 that it does not infringe the ‘D968 patent. Nikola asserts that Tesla infringes the ‘D968 patent and Tesla has failed to allege the necessary elements to state a claim for declaratory judgment of noninfringement.

40. Denied.

FOURTH COUNTERCLAIM – DECLARATION OF PATENT INVALIDITY
OF THE ‘D968 PATENT.

41. Nikola incorporates Paragraphs 1-13 of its Answer to Tesla’s Counterclaim as if fully set forth.

42. Nikola admits that Tesla purports to allege in paragraph 42 that the ‘D968 Patent is invalid. Nikola denies that the ‘D968 patent is invalid and asserts that Tesla has failed to allege the necessary elements to state a claim for declaratory judgment of patent invalidity.

43. Nikola denies that any of the references cited are invalidating prior art. Nikola has no knowledge of the veracity or authenticity of the pictures included in paragraph 43 and as such denies the allegations on that basis.

44. Nikola denies that Tesla is entitled to a judicial declaration that the ‘D968 Patent is invalid.

FIFTH COUNTERCLAIM – DECLARATION OF NONINFRINGEMENT
OF THE ‘D004 PATENT.

45. Nikola incorporates Paragraphs 1-13 of its Answer to Tesla’s Counterclaim as if fully set forth.

46. Nikola admits that Tesla purports to allege in paragraph 46 that it does not infringe the ‘D004 patent. Nikola asserts that Tesla infringes the ‘D004 patent and Tesla has failed to allege the necessary elements to state a claim for declaratory judgment of noninfringement.

47. Denied.

SIXTH COUNTERCLAIM – DECLARATION OF PATENT INVALIDITY
OF THE ‘D004 PATENT.

48. Nikola incorporates Paragraphs 1-13 of its Answer to Tesla’s Counterclaim as if fully set forth.

49. Nikola admits that Tesla purports to allege in paragraph 49 that the ‘D004 Patent is invalid. Nikola denies that the ‘D004 patent is invalid and asserts that Tesla has failed to allege the necessary elements to state a claim for declaratory judgment of patent invalidity.

50. Nikola denies that any of the references cited are invalidating prior art. Nikola has no knowledge of the veracity or authenticity of the pictures included in paragraph 50 and as such denies the allegations on that basis.

51. Nikola denies that Tesla is entitled to a judicial declaration that the ‘D004 Patent is invalid.

SEVENTH COUNTERCLAIM – DECLARATION OF NONINFRINGEMENT
OF THE ‘084 PATENT.

52. Nikola incorporates Paragraphs 1-13 of its Answer to Tesla’s Counterclaim as if fully set forth.

53. Nikola admits that Tesla purports to allege in paragraph 53 that it does not infringe the ‘084 patent. Nikola asserts that Tesla infringes the ‘084 patent and Tesla has failed to allege the necessary elements to state a claim for declaratory judgment of noninfringement.

54. Denied.

EIGHTH COUNTERCLAIM – DECLARATION OF PATENT INVALIDITY
OF THE ‘084 PATENT.

55. Nikola incorporates Paragraphs 1-13 of its Answer to Tesla’s Counterclaim as if fully set forth.

56. Nikola admits that Tesla purports to allege in paragraph 56 that the ‘089 Patent is invalid. Nikola denies that the ‘089 patent is invalid and asserts that Tesla has failed to allege the necessary elements to state a claim for declaratory judgment of patent invalidity.

57. Nikola denies that any of the references cited are invalidating prior art. Nikola, on that basis, denies the allegations in paragraph 57.

58. Nikola denies that Tesla is entitled to a judicial declaration that the ‘089 Patent is invalid.

**NINTH COUNTERCLAIM – DECLARATION OF NONINFRINGEMENT OF
NO TRADE DRESS INFRINGEMENT.**

59. Nikola incorporates Paragraphs 1-13 of its Answer to Tesla’s Counterclaim as if fully set forth.

60. Nikola admits that Tesla purports to allege in paragraph 60 that it does not infringe the trade dress of the Nikola One. Nikola asserts that Tesla infringes the Nikola One trade dress and that the Nikola One trade dress is protectable.

61. Denied.

**TENTH COUNTERCLAIM – DECLARATION JUDGEMENT OF
NO TRADE DRESS RIGHTS**

62. Nikola incorporates Paragraphs 1-13 of its Answer to Tesla’s Counterclaim as if fully set forth.

63. Nikola denies that the Nikola One trade dress is not inherently distinctive, has acquire no secondary meaning, and is functional. Nikola asserts that Tesla has failed to adequately plead its claim of no trade dress rights.

64. Denied.

**ELEVENTH COUNTERCLAIM – DECLARATION OF PATENT
UNENFORCEABILITY**

65. Nikola incorporates Paragraphs 1-30 of its Answer to Tesla’s Counterclaim as if fully set forth.

66. Denied.

67. Denied.

1 68. Denied.

2 **PRAYER FOR RELIEF**

3 69. Nikola denies that Tesla is entitled to any relief that it was set out in its prayer
4 for relief.
5

6 **DEMAND FOR JURY TRIAL**

7 70. This paragraph is Tesla's demand for a jury trial under Federal Rule of Civil
8 Procedure 38(b). No response is required.
9

10 **AFFIRMATIVE DEFENSES**

11 Without prejudice to the denials set forth above and without undertaking any burden
12 imposed on law imposed on Nikola for its counterclaims, Nikola asserts the following
13 Affirmative Defenses to Tesla's Counterclaim.
14

15 **FIRST AFFIRMATIVE DEFENSE: FAILURE TO STATE A CLAIM**

16 71. Tesla has failed to state a claim for patent noninfringement, patent invalidity,
17 patent unenforceability, trade dress noninfringement and no trade dress rights under Federal
18 Rule of Civil Procedure 12(b)(6).
19

20 **SECOND AFFIRMATIVE DEFENSE: UNCLEAN HANDS**

21 72. Tesla's counterclaims are barred in whole or part by Tesla's unclean hands.
22

23 **THIRD AFFIRMATIVE DEFENSE: FAILURE TO STATE**
24 **AN EXCEPTIONAL CASE**

25 73. Tesla's counterclaims fail to state a claim for an exceptional case under 35
26 U.S.C. § 285 and applicable case law.
27
28

FOURTH AFFIRMATIVE DEFENSE: ADDITIONAL DEFENSES

74. Nikola reserves the right to present any additional defenses or claims that discovery may reveal.

DATED: October 14, 2020

Respectfully submitted,

By /s/ K. Reed Willis
K. Reed Willis

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CERTIFICATE OF SERVICE

I hereby certify that on October 14, 2020, I electronically transmitted the foregoing document to the Clerk's Office using the ECF System for filing and transmittal of a Notice of Electronic Filing to the following ECF registrants:

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